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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/348,529	07/07/1999	ALAN SLATER	CITI0109-US	5359

27510 7590 10/30/2003
KILPATRICK STOCKTON LLP
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WASHINGTON, DC 20005

EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/348,529

Applicant(s)

Slater

Examiner

Feiten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/14/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-33, 35-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-33, 35-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

DETAILED ACTION

1
2 1. Receipt of the amendment filed August 14, 2003 amending claims 1-10, 17-18, 20, 24,
3 26-33, 38-42 and 45-47 canceling claims 12 and 34 is acknowledged. Claims 1-11, 13-33 and
4 35-49 remain pending in the application and are presented to be examined upon their merits.

Response to Arguments

5
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7 2. Applicant's arguments filed August 14, 2003 have been fully considered but
8 they are not persuasive. Applicant has argued primarily based upon applicant's amendment,
9 however, Office action mailed May 16, 2002 where to address claims that had been presented
10 November 22, 2002. The comments presented below will address the amendment filed August
11 14, 2003:

12
13 Applicant's newly presented claim language, for the most part discloses, a method for
14 image based transactions involving the manipulation of a *check*, as opposed to an *instrument*,
15 as previously claimed. Applicant has argued that the cited art, "neither singularly nor in
16 combination, teach or suggest the steps of,

17 "receiving at a first location at least one *check* having a front face and a back face; scanning the front and
18 back face and back face and the back face of said at least one of the check and cash to create a deposit check
19 or an electronic validation of deposited cash"
20

1 It is apparent that applicant fails to recognize the level of ordinary skill in the art or to
2 appreciate how references were evaluated by what the cited in prior art would suggest to one
3 versed in the art rather than their specific disclosure [see *In re Bozek*, 163 USPQ 545 (CCPA
4 1969)]. Here the primary reference (Moreau) discloses an improvement/extension to check
5 processing systems by providing payer check truncation via a scanning fax machine (see
6 Moreau col. 1, ll. 46+). The main advantage of Moreau's invention is to provide smooth
7 migration from a paper based payment system (i.e. paper check) to electronic payment system
8 (see Moreau, col. 8, ll. 52+). The value transfer form is viewed as an art recognized
9 equivalent to a check because it functions in the same manner. Additionally information on
10 paper checks, forms etc., may be found on both sides of a paper. It has been already argued by
11 the examiner that one of ordinary skill in the art would have recognized the convenience of
12 integrating a dual scanning fax machine into the Moreau system to provide the ability to scan
13 documents with printed information on both sides. The ability to scan documents (i.e. checks)
14 on both sides would rise to the level of one of ordinary skill in the art because an artisan would
15 recognize from Moreau that checks, cash and other documents normally have pertinent
16 information written on both sides and would have sought to use a fax/scanner that would be
17 able to conveniently scan both sides simultaneously. Thus such a modification would have
18 been an obvious extension to the teachings of Moreau. Thus the rejection of Claims 1-11, 13-
19 33 and 35-49 is maintained.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor **Vincent Millin** whose telephone number is (703) 308-1065.

5. Response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

1
2 for formal communications intended for entry, or (703) 305-0040, for informal or draft
3 communications, please label "Proposed" or "Draft".

4 Communications via Internet e-mail regarding this application, other than those under 35
5 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
6 addressed to [daniel.felten@uspto.gov].
7

8 All Internet e-mail communications will be made of record in the application file. PTO
9 employees do not engage in Internet communications where there exists a possibility that
10 sensitive information could be identified or exchanged unless the record includes a properly
11 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
12 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
13 Trademark on February 25, 1997 at 1 195 OG 89.

14
15 

16 DSF
17 October 28, 2003





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